

09/522,085
Art Unit 3624
9137.00

Pl
a remote source.

REMARKS

This Amendment is submitted in response to the Office Action mailed on December 18, 2002. Claims 1 - 8 and 15 - 29 are pending, and all stand rejected at present.

Response to Objection to Title

Applicant requests that a new title be suggested. One reason for this is that the existing title appeared to be acceptable at the time of the first Office Action. Applicant cannot be required to guess at the supposed defects in the title.

Response to Objection to Abstract

A new Abstract is herewith submitted.

Response to 112 - Objections

Claim 1

In response to the objection to claim 1, Applicant requests that a court decision be supplied in support of the objection.

One reason is that claim 1 recites:

1. A method comprising:

identifying an ATM which has a screen for displaying options for withdrawing cash and a

09/522,085
Art Unit 3624
9137.00

touch input mechanism for receiving user commands;

and

modifying said ATM to enable it to receive from a wireless telephone user commands for dispensing cash.

RE: RELATIONSHIPS

The objection asserts that certain "relationships" are missing from the claim, including (1) how the identifying step is **related** to the ATM and (2) the functional **relationship** relating to the screen for displaying the options.

In response, Applicant points out that the objection must contain typographical errors, because the second relationship supposedly missing ("the functional relationship relating to the screen for displaying the options") appears to make no sense. That is, the second assertion merely refers to a **single** element (the screen for displaying the options). But a **single** element cannot have a relationship with itself.

Restated, the second assertion has not identified **two** elements, between which a relationship is supposedly missing.

As to the first assertion (how the identifying step is related to the ATM), Applicant points out that Applicant is not required to set forth any such "relationship."

From another point of view, a relationship is present. The

09/522,085
Art Unit 3624
9137.00

claim refers to **identifying** an ATM having two specific characteristics (a screen for displaying options for withdrawing cash, and a touch input mechanism for receiving user commands). That is, an identification process is undertaken, and, as a result, an ATM is identified. That shows a relationship. An action is undertaken (identification) and a result occurs (a specific ATM is tagged, or identified). That is a relationship.

It can be viewed as the relationship between a verb and a direct object, in grammatical terms. One definition of a direct object is "a noun that denotes the receiver of the action expressed by the verb." Here, the ATM is that noun, and the verb is the identification process, or "identifying." The relationship is that of verb-direct object.

From yet another point of view, Applicant submits that the objection is misplaced, as a matter of logic. The objection wants a "relationship" between an action (identification) and a physical object (an ATM). Applicant is not prepared to admit that, as a matter of logic, a concept of "relationship" for patent purposes is appropriate in this case.

RE: MODIFYING STEP

The 112 - objection further asserts that "it is unclear of what is a modifying step." In response, Applicant points out that the phrase "modifying step" does not appear in the claim.

09/522,085
Art Unit 3624
9137.00

Further, mere "modifying" is not recited in the claim. The claim states that the "modifying" causes a specific result:

. . . modifying said ATM to enable it to
receive from a wireless telephone user
commands for dispensing cash.

That seems to be perfectly clear. If an infringer does not "[modify] said ATM to enable it to receive from a wireless telephone user commands for dispensing cash," then the infringer would not infringe this claim recitation.

Claim 15

The preceding applies to claim 15.

In addition, the objection asserts that "what is being modified by the modifying step" is unclear. In response, Applicant points out that claim 15 recites "modifying the SST." The SST is modified.

Response to 103 - Rejections

All claims were rejected as obvious, based on Monaghan.

Monaghan does not Preclude Patentability

If Monaghan is being used as a publication, it is not available, as explained below.

09/522,085
Art Unit 3624
9137.00

Monaghan is available, if at all, as a reference only under section 102(e). But that is doubtful, because Monaghan is not a patent.

But even if Monaghan is used, section 103(c) states that, in such a case, if the subject matter of the reference (ie, Monaghan) and the claimed invention were owned by the same person, or subject to an obligation of assignment to the same person, then the reference (ie, Monaghan) does not preclude patentability.

Restated, Monaghan and the present invention are commonly owned.

In this case, Monaghan is assigned to NCR Corporation, which is the same assignee as the present application. In fact, the party "Michael Chan" listed in the correspondence address of Monaghan is the same "Michael Chan" identified as the addressee of the Office Action to which this Amendment is responding.

Monaghan not Available as Reference

Monaghan is a publication, not a patent. Its date of publication is May 30, 2002.

Applicant's filing date is March 10, 2000. Applicant's filing date precedes the publication date of Monaghan. Monaghan is not available as a reference.

09/522,085
Art Unit 3624
9137.00

Even if Monaghan Available as Reference, Claim Elements Missing

"IDENTIFYING" IS ABSENT

Claim 1 recites **identifying** an ATM having certain characteristics: (1) a screen for displaying options for withdrawing cash and (2) a touch input mechanism for receiving user commands. Claims 15 and 20 contain similar recitations.

The undersigned attorney cannot locate the recited identification step in Monaghan, and requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify it in Monaghan.

On March 18, 2003, the undersigned attorney downloaded the Monaghan reference from the PTO's web site, and searched for the terms "identif," "identify," and "locat." The former two terms were not found in Monaghan. The last term ("locat") appeared in two locations, but those two locations did not discuss "locating an ATM" having certain characteristics.

Therefore, Applicant requests the PTO to explain how Monaghan shows identification of the ATM (or SST) as claimed, when Monaghan does not use the word "identify," or its conjugates.

RECITED "DISPENSING CASH" IS ABSENT

The Office Action asserts that Monaghan shows "wireless telephone user commands for dispensing cash." (Office Action, page 4, section 9, third paragraph.)

09/522,085
Art Unit 3624
9137.00

The undersigned attorney cannot confirm this, and requests that the PTO specifically identify this in Monaghan.

In this connection, Applicant points out that Monaghan does not appear to discuss a human user at all. He discusses a diagnostic system, wherein a management center interrogates ATMs using wireless links, to determine the status of various components, such as printers. The management center can thus shut down faulty components, such as printers. (Paragraph 0010.)

But the undersigned attorney can find no discussion of a human user using a wireless system to dispense money.

On March 18, 2003, the undersigned attorney did a word search of Monaghan, for the term "money," and received no hits. A search of "cash" yielded hits such as in paragraph 0017, which discussed returning a "facility" such as "cash dispensing" to operation. That is consistent with Monaghan's diagnostic system, but is not consistent with a user using wireless commands to obtain cash.

This applies to the remaining independent claims, which recite "user commands," "transactions," or both. Monaghan's management system does not show these elements.

Official Notice

The Office Action takes Official Notice of retrofitting. The undersigned attorney respectfully traverses the Official Notice, and requests a citation of evidence showing the practice. (See

09/522,085
Art Unit 3624
9137.00

MPEP § 2144.03.)

One reason is that no evidence has been given which shows that the Noticed retrofitting lies in a technical field which is analogous to Monaghan. That is, the Official Notice merely refers to retrofitting of a "system" in general terms.

In addition, Applicant points out that the device of Official Notice does not remove the requirement that a teaching be shown for combining the Noticed material with Monaghan. No teaching has actually been given.

Further, even if the PTO's reasoning in the paragraph bridging pages 4 and 5 of the Office Action be accepted, it still does not show the claimed invention. That is, the PTO first asserts that "retrofitting" generally is well known. Then the PTO asserts that it is obvious to allow customers ("users") of Monaghan to use wireless devices to communicate with ATMs.

However, the reasoning is a non sequitur. The one concept does not follow, and is not even related to, the other.

That is, the existence of retrofitting as an abstract concept does not imply that Monaghan should give users wireless devices to deal with ATMs.

From another point of view, the Office Action has failed to show retrofitting in the ATM art. Thus, no connection has been made between retrofitting and Monaghan.

In addition, the PTO's reasoning is incomplete. Retrofitting

09/522,085
Art Unit 3624
9137.00

is one of several possibilities. For example, the undersigned attorney owns at least one four-wheel drive vehicle. He purchased a two-wheel drive Jeep, which was available as a four-wheel drive version.

He recently investigated the possibility of converting (retrofitting) the Jeep to a four-wheel version. While he does not today recall the precise details, he recalls that, while retrofitting may be possible, the cost was prohibitive. It appeared more practical to sell the two-wheel Jeep, and take the money and purchase a four-wheel Jeep.

Therefore, this is one example illustrating why retrofitting is not always desirable.

Consequently, Applicant submits that the PTO must provide a line of reasoning as to why a person skilled in the art would modify Monaghan, to attain the claimed invention. Also, the elements of the claims must be shown in the prior art.


09/522,085
Art Unit 3624
9137.00

Conclusion

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


Gregory A. Welte
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 5
Dayton, OH 45479
March 18, 2003

(937) 445 - 4956

WELTE DIRECT: (765) 296 - 4699